



No. 78-1615

IN THE
Supreme Court of the United States
OCTOBER TERM, 1978

GRAYHILL, INC., *Petitioner,*

v.

AMF INC. AND MICRO-PRODUCTS ENGINEERING CO.,
Respondents.

**BRIEF IN OPPOSITION TO PETITION FOR
WRIT OF CERTIORARI TO THE UNITED STATES
COURT OF APPEALS FOR THE THIRD CIRCUIT**

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INTRODUCTION

Decisions below in this case do not properly present the four questions Petitioner seeks to have the Court review. Even resolution of all four questions in Petitioner's favor would not change the judgment below. Except for the possible conflict among circuits concerning the first question, Petitioner has not stated any effective reason for granting the writ.

QUESTION 1

If there is a conflict¹ among the Circuit Courts of Appeal concerning "a synergistic effect," this is not a proper case to resolve such a conflict. Conclusions of Law numbers 11, 13 and 14 (App. pp. 92a-93a), state three additional reasons relied upon by the District Court in holding the Garcia patent invalid. Hence, the affirmance by the Third Circuit Court of Appeals was not necessarily based upon lack of a "synergistic effect" (Conclusions of Law numbers 6 and 12 (App. pp. 90a, 92a)) about which Petitioner complains. Reversal of those two Conclusions of Law will not change the decisions below.

QUESTION 2

In determining obviousness, the District Court carefully followed the inquiries outlined by this Court in *Graham v. John Deere*, 383 U.S. 1, 15 L.Ed.2d 545, 86 S.Ct. 684 (1966) (Findings Numbers 7.01-7.21—App. pp. 32a-69a). No guidance by the Third Circuit Court of Appeals was necessary. Petitioner's improper characterization of "Piecpart Selection of Elements" (Petition, pp. 8-9) should not create an issue for this Court to resolve. Petitioner does not even refer to an error in the trial Court's decision. No reason appears in the Petition for the Court to review this question.

QUESTION 3

On the issue of infringement, Petitioner is in effect asking this Court to review Findings of Fact numbers 10.01-10.11 (App. pp. 81a-83a) and specifically Find-

¹ Petitioner's statement that the decision of the Third Circuit Court of Appeals is in direct conflict with decisions of that circuit is in error.

ing number 10.11 (App. p. 83a) upon which Conclusion of Law 28 (App. p. 97a) is based. Decisions below are not contrary to the law upon which Petitioner relies.

QUESTION 4

In concluding that claims of the Garcia patent are invalid because the original disclosure was inoperative, the District Court made extensive findings (Findings numbers 9.01-9.29—App. pp. 73a-80a), and specifically recognized that the determination of the Patent Office to permit amendment of the drawing is presumptively correct (Finding 9.05—App. p. 74a). Nevertheless, the District Court rejected Grayhill's argument that corrections to the drawings would have been apparent to one skilled in the art (Finding number 9.13—App. pp. 76a-77a). Based upon these findings, the decisions below are not in conflict with decisions cited in the Petition.

CONCLUSION

The Petition for Writ of Certiorari should be denied. This is not a proper case for review of the questions presented in the Petition.

Respectfully submitted,

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